

Group VI: Claims 155-158, drawn to powder application carriage bearing product and nonproduct portions.

Group VII: Claims 159-162, drawn to platen comprising a vacuum chamber and electrical means.

In order to be responsive to the Office's requirement, Applicants elect the invention of Group I. However, Applicants make this election with traverse, for the reasons given in the response filed January 16, 2006, which is incorporated by reference. The Office does not even attempt to rebut this traversal in the Office action dated March 25, 2010. Instead, the Office includes an additional group, Group IV, claims 142-151 in the restriction requirement.

In attempting to justify its erroneous restriction requirement, the Office states:

Note 1: In Groups I and II, the special technical feature does not define a contribution to and over the known prior art, according to PCT Rule 13.2 and therefore method and apparatus further lack Unity of Invention. Specifically, GB 2402895 teaches a continuous path of platens on which substrates are transported in an electrostatic coating process.

Office action dated March 25, 2010 at pages 2-3.

First, nowhere has the Office provided a citation to any authority for asserting that the existence of a piece of prior art that allegedly discloses that the "special technical feature" of Applicants' claims exactly corresponds to what is allegedly shown in the art justifies ignoring the requirements of PCT Rule 13.1 and 13.2. To the contrary, 37 C.F.R. § 1.475(a), which is the U.S. implementation of the PCT rules, requires that the Office define "special technical feature" as "those technical

features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art" (emphasis added).

Rather than consider the inventions of the group of claims as a whole, the Office has focused on what it considers to be the "special technical feature" in a vacuum, has narrowly defined this alleged special technical feature," and has then alleged that this narrow feature is shown in the art, as a mechanism to circumvent the requirements of PCT 13.1 and 13.2. However, nothing in 37 C.F.R. § 1.475(a) justifies such an approach. Applicants submit that this approach is improper, and that the restriction requirement should be withdrawn.

Second, the Office only sets forth the allegation noted above with respect to Groups I and II. Since the Office has seen fit to impose a seven-way restriction, it is incumbent on the Office to explain how its logic applies to each permutation of groups. Since it has not done so, it has not satisfied its burden to establish that restriction is proper.

For at least the reasons given above, Applicants submit that the requirement for restriction is erroneous, and should be withdrawn.

Respectfully submitted,

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Date: April 26, 2010

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